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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,846

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EXAMINER

LAM, DUNG LE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,846	<b>Applicant(s)</b> KIM ET AL.	
	<b>Examiner</b> DUNG LAM	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/08/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Double Patenting*

The examiner notes that a Terminal Disclaimer was filed on 6/22/09. However, the terminal disclaimer contained incorrect language. *TD stated "prior patent", however, it should state "prior copending application". Thus the following double patenting rejection is repeated.*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 47.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the corresponding claim 6 of the copending Application No. 10/537144. Claim 1b through 1c of 10/537846 corresponds to 6a through 6c of 10/537144 respectively. The only difference is 1a of 10/537846 specifically requires that the position is from the base station in which one of the reference shows (see rejection below) that it is an obvious variance to store data either remotely at a base station or at a MS.

3. Claim 7 is are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the corresponding claim 1 of Application No. 10/537144. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of the pending application has substantially the same limitations as the combined claims 7 of the co-pending claim. For easy reference the limitations are sequentially labeled from a through d. The correspondence of the claims is as followed.

Limitation 1c of application 10/537144 same as 7b of application 10/537846

Limitation 1a of application 10/537144 same as 7c of application 10/537846

Limitation 1d of application 10/537144 same as 7d of application 10/537846

Limitation 1b of application 10/537144 same as 7a of application 10/537846

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-4, 6-10** rejected under 35 U.S.C. 103(a) as being obvious over

**Gunnarsson et al** (US Number 2003/0118015) in view of **Souissi** (US 2002/0187780).

1. Regarding **claim 1**, **Gunnarsson** teaches in a method for searching a wireless LAN AP (access point) in a terminal having a wireless LAN module, a mobile communication module, and a GPS receiving module installed therein, a method for automatically searching a wireless LAN AP comprising:

- (a) acquiring location information of the wireless LAN AP provided in a service area of a base station from the base station ([22]).
- (b) consecutively tracking a current location of the terminal through the GPS receiving module ([18, 19, 21, 24, 25 and 28]);
- (c) determining a driving start time of the wireless LAN module through the location information of the wireless LAN AP acquired in (a) and the current location information of the terminal tracked in (b) ([22, 24, 25, 28]); and
- wherein the driving start time is activated when the current location information of the terminal tracked in (b) is within a predetermined radius of service information of the location information of the wireless LAN AP acquired in (a) (wlan module is triggered to search/scan for wlan network if the mobile terminal is within a predetermined range of one or more wlan, as measured from the center of the wlan [distance from center equals to radius], [22, 24, 25, 28]);
- (d) driving the wireless LAN module to detect a beacon signal periodically output by the wireless LAN AP ([24, 28]).

However, **Gunnarsson** does not specifically teach acquiring the location information through the mobile communication module. In an analogous art, **Souissi** teaches position information of the WLAN access point are obtained through the mobile communication module (roaming table of containing geographic locations of preferred networks which can be a WLAN which contains AP [55], [0065-0067, 82-86]).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Gunnarsson's teaching of the MS to operate the WLAN

module to detect a nearby access point with Souissi's teaching of obtaining the AP location through the mobile communication module so that the AP location information can be stored locally and thus easily and quickly be compared the MS' position without having to query the information from the system thus minimize system resource usage.

2. Regarding claim **2**, **Gunnarsson and Souissi** teach the method of claim 1, wherein (a) comprises: transmitting a location register/update message to the base station through the mobile communication module when the terminal reaches the service area of the base station (Gunnarsson, MS transmits position to network communication 10); receiving a response/success/failure message on the location register/update process from the base station (Gunnarsson, network 10 responds with a notification of wlan detected at the current position [22,23]); and acquiring location information of the wireless LAN AP provided in the base station from the response/success/failure message received from the base station (**Souissi**, roaming table [55], [0065-0067, 82-86]).

3. Regarding claim **3**, **Gunnarsson and Souissi** teach the method of claim 1 or 2, wherein (b) is performed when the location information provided in the base station is acquired in (a) (**Gunnarsson** [22]).

4. Regarding claim **4**, **Gunnarsson and Souissi** teach the method of claim 1 or 2, wherein the terminal stores the location information of the wireless LAN AP acquired in (a) in a specific AP location information depository (**Souissi**, roaming table [55], [0065-0067, 82-86]).

5. Regarding claim **6**, **Gunnarsson and Souissi** teach the of claim 5, wherein the driving start time of the wireless LAN module is determined by comparing the geographical location information of the wireless LAN AP, the radius of service information on the wireless LAN AP, and location information of the terminal tracked through the GPS receiving module (**Gunnarsson**, from center of WLAN, [22]).

6. Regarding claim **7 and 10**, they are apparatus claim and computer readable medium claims that correspond to claims 1 thus are rejected for the same reasons as claim 1.

7. Regarding claim **8**, it is apparatus claim that corresponds to claim 2 thus is rejected for the same reasons as claim 2.

8. Regarding claim **9**, **Gunnarsson and Souissi** teach the terminal of claim 7, but do not explicitly teach wherein the wireless LAN AP is not automatically searched when the mobile communication module fails to acquire location information of the wireless LAN AP provided in the base station. However, the examiner notes Gunnarsson emphasized the concept of battery saving by not continuously searching for the WLAN ([0004 and 0017]). Therefore, it would have been obvious and common sense for one of ordinary skill in the art to design Gunnarsona and Souissi's teaching to not automatically search for WLAN if the location is not acquired in order to minimize battery consumption.

***Allowable Subject Matter***

9. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-4, 6-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Citation of Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Publication No. 2003/0040314 discloses a method of updating a location registration.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUNG LAM whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 5:30 pm, Every Other Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/  
Supervisory Patent Examiner, Art Unit 2617